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In re Application of :
TITZ, Peter :
U.S. Application No.: 10/530,325 :
PCT No.: PCT/IB2003/004353 :
Int. Filing Date: 03 October 2003 :
Priority Date: 02 October 2002 :
Attorney Docket No.: 234853 :
For: SEALING, TRIMMING OR GUIDING :
STRIPS :

DECISION

This decision is in response to the papers filed with the United States Designated/Elected Office (DO/EO/US) on 19 October 2006.

BACKGROUND

On 25 November 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 24 August 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to timely respond to the Form PCT/DO/EO/905 mailed

On 19 October 2006, applicants filed a petition to revive under 37 CFR 1.137(b) which was accompanied by, inter alia, a petition under 37 CFR 1.47(b); a five-month extension and fee; a petition fee of \$130.00; a declaration signed by the 37 CFR 1.47(b) applicant for the nonsigning inventor; a statement of facts signed by Norbert Heller; a statement of facts signed by Dr. Armin Großklaus; a copy of an agreement between GDX Automotive TC GmbH & Co. KG and GDX North America Inc.; a copy of an agreement between Mr. Peter Titz and GDX Automotive TC GmbH & Co. KG dated 20 September 2002 with an English translation; and authorization to charge any required fee to Deposit Account No. 12-1216.

DISCUSSION

Applicant filed a petition to revive under 37 CFR 1.137(b) which requires (1) the proper reply (2) the petition fee (3) a statement that the entire delay in filing the

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required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer if required.

The petition fee of \$1,500 has been charged to Deposit Account No. 12-1216 as authorized. A statement of unintentional delay was submitted. Item (4) is not required. Items (2), (3) and (4) are satisfied.

Regarding item (1) of 37 CFR 1.137(b), petitioner filed a petition under 37 CFR 1.47(b) in lieu of an executed declaration. Therefore, this item will be satisfied upon satisfying all requirements of 37 CFR 1.47(b).

Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of the nonsigning joint inventor (5) evidence showing sufficient proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Concerning item (1), the petition fee of \$200.00 has been charged to Deposit Account No. 12-1216 as authorized.

With regards to item (3), the home address of the nonsigning joint inventor is given as:

Gotzweg 112
Monchengladbach, Germany 41238

Concerning item (4), the 37 CFR 1.47(b) applicant submitted a declaration signed by Janice Stipp, Executive Vice President and COO of GDX North America, Inc. on behalf of Mr. Titz. The position of COO is presumed to have the authority to sign for an organization. See MPEP § 324.

A review of the declaration shows that it is in compliance with 37 CFR 1.497(a) and (b) as the residence, address and citizenship of the sole inventor are recorded on the declaration. Item (4) is satisfied.

With regards to item (5), section 409.03(f) of the MPEP discusses proof of proprietary interest and states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner claims sufficient proprietary interest in the above-identified application by virtue of an agreement between GDX Automotive TC GmbH & Co. KG and GDX North America Inc. A copy of this agreement was provided. GDX Automotive TC GmbH & Co. KG have proprietary interest in the subject application from the inventor by virtue of an agreement executed by the sole inventor and GDX Automotive TC GmbH & Co. KG on 20 September 2002. This agreement provides unrestricted use of the invention. A copy of the signed agreement was also submitted. Petitioner also provided a statement by Dr. Armin Großklaus who states that he "witnessed Mr. Titz conceive and develop the invention disclosed in PCT application PCT/IB2003/004353 upon which I understand that the above-identified invention and claims are based."

This evidence meets the requirements of the MPEP and is sufficient to satisfy item (5).

Regarding item (6), the 37 CFR 1.47(b) applicant states that "[f]iling on behalf of the nonsigning inventor is necessary to preserve the rights of the parties and to prevent irreparable damage." This statement satisfies item (6).

Thus, items (1), (3), (4), (5) and (6) of 37 CFR 1.47(b) are complete.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that the sole inventor refuses to join in the application. Petitioner submitted a statement by Norbert Heller who claims that he gave Mr. Titz a copy of the declaration for the subject application in August 2005. In September 2005, Mr. Heller claims that the sole inventor told him he would not sign the document. This conduct would constitute an oral refusal to cooperate and be sufficient to satisfy item (2) of 37 CFR 1.47(b). However, petitioner must show that Mr. Titz received a complete copy of the subject application (specification, claims and drawings) for a refusal to be accepted. See MPEP § 409.03(d).

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A review of the petition shows no evidence that a complete copy of the application was presented to the nonsigning inventor. Therefore, the purported refusal to cooperate is not accepted.

For this reason, item (2) is not yet satisfied.

CONCLUSION

For the reason discussed above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

A five-month extension and \$2,160.00 fee is not required. This fee has been credited back to counsel's Deposit Account No. 12-1216.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302